



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,772	06/25/1999	WILLEM JAN MARIE VAN DE VEN	702-990278	1485

7590 07/30/2004

RUSSELL D ORKIN
700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH, PA 152191818

EXAMINER

SPIEGLER, ALEXANDER H

ART UNIT	PAPER NUMBER
----------	--------------

1637

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

MS

SM.

Advisory Action

Application No.

09/242,772

Applicant(s)

VAN DE VEN ET AL.

Examiner

Alexander H. Spiegler

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 28,29,32-48 and 50-52.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE:

Applicants' have cancelled all previous claims and have added all new claims.

Claim 53 recites, "an isolated nucleic acid sequence consisting of 7313 base pairs as depicted in Figure 4A or consisting of the open reading frame of 1500 base pairs starting with the ATG at position 481-483 as depicted in Figure 4A, wherein said open reading frame encodes for a pleomorphic adenoma gene 1 (PLAG1) protein." This claim would raise an issue under 112, 2nd paragraph over the recitation of "as depicted in Figure 4A." Specifically, it is not clear whether this refers only to the length of the claimed sequence or to the specific sequence recited in Figure 4A. In addition, this claim would also raise new issues that required further search and consideration because the claim does not appear to be limited to a nucleic acid of a particular sequence, but rather to any nucleic acid encoding an ORF for a PLAG1 protein.

Claim 54 is drawn to a hybrid nucleic acid sequence "consisting of a fragment of the nucleic acid of Claim 53 fused to a nucleic acid sequence derived from a translocation partner of PLAG1, wherein the presence of said hybrid nucleic acid sequence allows for the diagnosis of a cell containing said hybrid nucleic acid sequence as a tumor cell." Previously, the claims were not drawn to a nucleic acid hybrid consisting of a fragment of the nucleic acids of Claim 53 "fused to a nucleic acid sequence derived from a translocation partner of PLAG1." Previously, Claims 48 and 50-52 were drawn to a macromolecule comprising "CTNNB1", a fusion partner of PLAG1, however, the claims were not drawn to nor encompassed a "nucleic acid hybrid" consisting of "a nucleic acid sequence derived from a translocation partner of PLAG1," fused to another nucleic acid. Claim 54 would raise new issues under 112, 1st and 2nd paragraph because it is not clear as to what is encompassed by a nucleic acid sequence "derived" from a translocation partner of PLAG1, and furthermore, the specification has not provided an adequate written description of nucleic acids within the genus of "nucleic acids sequences derived from a translocation partner of PLAG1." Furthermore, the previous claims were not drawn to nor encompassed a nucleic acid hybrid "wherein the presence of said hybrid allows for the diagnosis of a cell containing said hybrid nucleic acid sequence as a tumor cell." Accordingly, further search and consideration would be required for the claimed nucleic acid hybrid.

Claim 58 is drawn to an anti-sense nucleic acid sequence "according to Claim 53 or fragments thereof which inhibit the expression of said nucleic acid sequence according to Claim 53 in tumor cells." Previously, the claims were not drawn to an anti-sense nucleic acid "which inhibit[s] the expression of said nucleic acid sequence according to Claim 53 in tumor cells," and therefore, further search and consideration of this anti-sense nucleic acid would be required.

Accordingly, because the newly proposed claims would require further search and consideration, the amendments have not been entered.

Continuation of 5. does NOT place the application in condition for allowance because of the reasons of record, and in view of the non-entry of the amendment filed on June 25, 2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander H. Spiegler whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday through Friday, 7:00 AM to 3:30 PM.

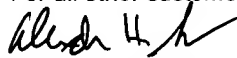
If attempts to reach the examiner are unsuccessful, the primary examiner in charge of the prosecution of this case, Carla Myers, can be reached at (571) 272-0747. If attempts to reach Carla Myers are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (571) 272-0782.

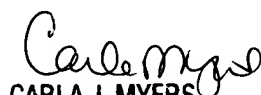
Papers related to this application may be faxed to Group 1637 via the PTO Fax Center using the fax number (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


Alexander H. Spiegler
July 27, 2004


CARLA J. MYERS
PRIMARY EXAMINER